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09/933,000	08/21/2001	Kouji Hirayama	Q65805	6965
7590 05/28/2004 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3213			EXAMINER ALEXANDER, LYLE	
			ART UNIT 1743	PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 052604

Application Number: 09/933,000
Filing Date: August 21, 2001
Appellant(s): HIRAYAMA ET AL.

MAILED

MAY 28 2004

GROUP 1700

Keiko K. Takagi
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/1/04.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 11-17 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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JP-A-4-188065

EP 0587222

(10) Grounds of Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-A-4-188065 (references as JP hereafter) in view of EP 0587222 (references as EP hereafter).

Applicants characterize JP-A-4-188065 on page 6 of the specification as teaching a device identical to that presently claimed.

In light of the 3/24/03 translation of the JP supplied by Applicants, the Office concurs with Applicants characterization of JP-A-4-188065 that the structure is identical except that JP-A-4-188065 fails to teach a black cover as presently claimed.

EP teaches a test apparatus for the analysis of a liquid. Figures 1-2 teach a support(12) with an aperture and support member(13) that is read on the claimed "support ... having a through hole and light permeable area". A reagent layer(14) is on the upper side of the support member(13) and cover (17) that faces the reagent layer(14). Page 6 lines 45+ teach a black pigmented means can be used between the absorbent area and are advantageous "... to absorb or block signals generated by washed label or other interferents from outside the read area ...". The read area has been read on the claimed black portion of the cover.

Additionally, one having ordinary skill in the art must possess a fundamental knowledge that black absorbs light over a broad range of wavelengths. Furthermore, EP (page 6) teaches an apparatus in the same filed of endeavor using a light absorbing material having a black color in order to fully absorb all lights that interferes with the measured or tested light.

It would have been obvious to one having ordinary skill in the art to modify the test apparatus of JP in view of EP and substitute a cover which absorbs light at all wave lengths, such as a black cover as taught by EP, to gain the advantage of "... to absorb or block signals generated by washed label or other interferences from outside the read area ..." thus permitting the cover to absorb light over a wider range of wavelengths.

(11) Response to Argument

Appellant acknowledges the primary reference JP-A-4-188065 teaches the same structure as presently claimed except for a black cover(5) (compare figure 1 from JP-A-4-188065 to that of figure 1 in the instant application). The only difference between the claims on appeal and JP-A-4-188065 is that cover(5) is claimed as black in the application. JP-A-4-188065 is silent to the color of cover(5). The Office cited EP 0587222 as teaching motivation to make the cover of JP-A-4-188065 black/reflective.

Appellant states there is insufficient motivation to make the combination above. Further, Appellant states assuming, *arguendo*, even if there were sufficient motivation to make the combination, it would not result in the invention as claimed here with a black cover(5). Appellant states EP 0587222 teach the black cover in contact with layer(3) and does not support a modification to make the cover(5) black.

The Office maintains the rejections are proper. The rejection highlights page 6 lines 45+ of EP 0587222 as teaching " black or pigment ... or any other absorbing or reflecting ... material ... absorb or block signals generated by ... interferences from outside the read area ..." thus permitting the cover to absorb light over a wider range of wavelengths. The Office believes this is sufficient motivation to modify JP-A-4-188065 to make the cover(5) black to gain the above advantages.

Appellant states the combination of JP-A-4-188065 in view of EP 0587222 would not result in the cover(5) being black, but rather an additionally black layer formed over layer(3) as depicted on page 8 of the Brief. The Office does not agree with Appellant. The teachings of EP 0587222 are sufficient to support modification of the existing cover(5) to contain black pigment. The Office has correctly employed the teachings of EP 0587222 and applied the pigment to the existing cover(5) of JP-A-4-188065.

Appellant argues with respect to claims 13-15 the combination of JP-A-4-188065 in view of EP 0587222 would not teach a black or reflective layer in contact with the reagent layer. The Office notes Appellant own admission on page 8 of the Brief states if the above combination were made, it would result in the black/reflective layer in contact with the reagent layer(3), which is indistinguishable from the limitations of claims 13-15. Thus Appellants own analysis state the combination of the art would result in the structure covered by claims 13-15. The Office does acknowledge Appellant is making the combination "*arguendo*" but maintains for the reasons of record sufficient motivation exists to make the combination.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Lyle A Alexander
Primary Examiner
Art Unit 1743

A handwritten signature in cursive script, appearing to read "Lyle A. Alexander".

LAA
May 26, 2004

Conferees
Ms. Jill Warden; Mr. Roy King

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